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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER	
SALIARD, SHANNON S	

ART UNIT	PAPER NUMBER
3639	

DATE MAILED: 09/23/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/080,565	CHENG ET AL.	
	Examiner	Art Unit	
	Shannon S. Saliard	3639	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *25 February 2002*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-30* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-30* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☒ Certified copies of the priority documents have been received in Application No. 10/080,565.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *06/03/03*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Information Disclosure Statement

1. The listing of references in the Search Report is not considered to be an information disclosure statement (IDS) complying with 37 CFR 1.98. 37 CFR 1.98(a)(2) requires a legible copy of: (1) each foreign patent; (2) each publication or that portion which caused it to be listed; (3) for each cited pending U.S. application, the application specification including claims, and any drawing of the application, or that portion of the application which caused it to be listed including any claims directed to that portion, unless the cited pending U.S. application is stored in the Image File Wrapper (IFW) system; and (4) all other information, or that portion which caused it to be listed. In addition, each IDS must include a list of all patents, publications, applications, or other information submitted for consideration by the Office (see 37 CFR 1.98(a)(1) and (b)), and MPEP § 609.04(a), subsection I. states, "the list ... must be submitted on a separate paper." Therefore, the references cited in the Search Report have not been considered. Applicant is advised that the date of submission of any item of information or any missing element(s) will be the date of submission for purposes of determining compliance with the requirements based on the time of filing the IDS, including all "statement" requirements of 37 CFR 1.97(e). See MPEP § 609.05(a).

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. **Claims 16-29** are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The basis of this rejection is set forth in a two-prong test of:

(1) whether the invention is within the technological arts; and

(2) whether the invention produces a useful, concrete, and tangible result.

For a claimed invention to be statutory, the claimed invention must be within the technological arts. Mere ideas in the abstract (i.e., abstract idea, law of nature, natural phenomena) that do not apply, involve, use, or advance the technological arts fail to promote the "progress of science and the useful arts" (i.e., the physical sciences as opposed to social sciences, for example) and therefore are found to be non-statutory subject matter. A claim limited to a machine or manufacture which has practical application in the technological arts is statutory. In most cases, a claim to a specific machine or manufacture will have practical application in the technological arts. See MPEP 2106, 2100-14 (quoting *In re Alappat,* 33 F.3d at 1544, 31 USQ2d at 1557). Additionally, for subject matter to be statutory, the claimed process must be limited to a practical application of the abstract idea or mathematical algorithm in the technological arts. See *In re Alappat* 33 F.3d at 1543, 31 USPQ2d at 1556-57 (quoting *Diamond V. Diehr*, 450 U.S. at 192, 209 USPQ at 10). For a process claim to pass muster, the recited process must somehow apply, involve, use, or advance the technological arts. See *In re Musgrave*, 431 F.2d 882, 167 USPQ 280 (CCPA 1970).

In the present case, claims 16-29 only recite an abstract idea. The recited steps of preparing a corporate travel request for approval by a supervisor that is transferred to an agent for obtaining a reservation does not apply, involve, use, or advance the technological arts since all of the recited steps can be performed in the mind of the user or by use of a pencil and paper. These steps only constitute an idea of how to reserve travel services in accordance with company policy.

Additionally, for a claimed invention to be statutory, the claimed invention must produce a useful, concrete, and tangible result. An invention, which is eligible or patenting under 35 U.S.C. 101, is in the "useful arts" when it is a machine, manufacture, process or composition of matter, which produces a concrete, tangible, and useful result. The fundamental test for patent eligibility is thus to determine whether the claimed invention produces a "use, concrete and tangible result". See *AT&T v. Excel Communications Inc.*, 172 F.3d at 1358, 50 USPQ2dat 1452 and *State Street Bank & Trust Co. v. Signature Financial Group, Inc.*, 149 F.3d at 1373, 47 USPQ2d at 1601 (Fed. Cir. 1998). The test for practical application as applied by the examiner involves the determination of the following factors"

(a) "Useful" – The Supreme Court in *Diamond v. Diehr* requires that the examiner look at the claimed invention as a whole and compare any asserted utility with the claimed invention to determine whether the asserted utility is accomplished. Applying utility case law the examiner will note that:

i. the utility need not be expressly recited in the claims, rather it may be inferred.

ii. if the utility is not asserted in the written description, then it must be well established.

(b) "Tangible" – Applying *In re Warmerdam*, 33 F.3d 1354, 31 USPQ2d 1754 (Fed. Cir. 1994), the examiner will determine whether there is simply a mathematical construct claimed, such as a disembodied data structure and method of making it. If so, the claim involves no more than a manipulation of an abstract idea and therefore, is nonstatutory under 35 U.S.C. 101. In *Warmerdam* the abstract idea of a data structure became capable of producing a useful result when it was fixed in a tangible medium, which enabled its functionality to be realized.

(c) "Concrete" – Another consideration is whether the invention produces a "concrete" result. Usually, this question arises when a result cannot be assured. An appropriate rejection under 35 U.S.C. 101 should be accompanied by a lack of enablement rejection, because the invention cannot operate as intended without undue experimentation.

In the present case, the claimed invention produces travel reservations (i.e., repeatable) in accordance with company policy for corporate travelers used in determining and selecting the best insurance policy (i.e., useful and tangible).

Although the recited process produces a useful, concrete, and tangible result, since the claimed invention, as a whole, is not within the technological arts as explained above, claims 16-29 are deemed to be directed to non-statutory subject matter.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. **Claims 1, 2, 7, 9-11, 13-16, 22, 24-26, 28, 29 and 30** rejected under 35 U.S.C. 102(e) as being anticipated by Vance et al [U.S. Patent No. 6,442,526].

As per **claims 1 and 16**, Vance et al discloses a travel system for a business entity, the business entity associating with at least a business partner, every employee of the business entity having an individual employee's identification code for logging in the travel system, the employee being required to register a travel application data into the travel system prior to a travel, the travel system comprising: an employee's basic data database for storing employee's basic data and the respective employee's identification codes; a travel data database for storing travel application data registered by the employees, each of the travel application data being respective to one said employee's identification code; a combination module for forming a travel service data by combining one of the employee's basic data and one of the travel application data in accordance with the respective employee's identification code (col 5, lines 1-17); and a

sending module for sending the travel services data to the business partner so as to enable the business partner to perform travel services accordingly (col 12, lines 29-32).

As per **claim 2**, Vance et al further discloses further includes a control module for informing a supervisor of said employee after said employee registering said travel application data and saving said travel application data into said travel data database, for allowing the supervisor to access said travel application data of said travel system, and for resaving said travel application data into said travel data database after the supervisor confirming said travel application data (col 5, lines 64-67; col 6 lines 1-12).

As per **claims 7 and 22**, Vance et al further discloses wherein said travel application data includes a departure time, an arrival time and a travel destination of the travel (col 5, lines 30-33).

As per **claims 9 and 25**, Vance et al further discloses wherein said business partner performs said travel services of airline reservation in accordance with said travel services data (col 11, lines 51-59).

As per **claims 10 and 24**, Vance et al further discloses wherein said business partner performs said travel services of hotel reservation in accordance with said travel services data (col 11, lines 60-65).

As per **claims 11 and 26**, Vance et al further discloses wherein said business partner performs said travel services of rental-car reservation in accordance with said travel services data (col 11, lines 66-67).

As per **claims 13 and 28**, Vance et al further discloses wherein said business partner is a travel agent (col 12,lines 37-32).

As per **claims 14 and 29**, Vance et al further discloses wherein said business entity communicates with said business partner through a network (col 4, lines 15-30).

As per **claims 15 and 30**, Vance et al further discloses wherein said network is an Internet (col 4, lines 15-30).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to

consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

4. **Claims 3-5, and 17-20** are rejected under 35 U.S.C. 103(a) as being unpatentable over Vance et al [U.S. Patent No. 6,442,526].

As per **claims 3, 17, and 18**, Vance et al discloses all the limitations of claims 1, 2 and 16. Vance et al does not explicitly disclose further including a decision module for determining whether or not said supervisor has confirmed said travel application data; and if positive, said combination module integrates said employee's basic data and said travel application data to form a travel services data with respect to said employee's identification code. However, Vance et al discloses a corporate reservation system in which an employee uses an identification code to login to the system, make a travel request, and a supervisor approves the travel request of the employee (col 6, lines 18-20). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to form the travel request of the employee only after receiving approval of the travel policy from a supervisor because regardless of the order of the steps the supervisor still has the capability of confirming whether or not the employee's request is within the company policy.

As per **claim 4**, Vance et al does not explicitly disclose wherein said business partner further includes a travel services sending module to form a travel services message in accordance with said travel services for being forwarded to said travel system, in which the travel services message is respective to one said employee's

identification code. However, Vance et al discloses that the travel services of an employee is forwarded to a travel system (col 7, lines 6-18). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to prepare the travel request of an employee respective of an employee identification code to uniquely identify each employee.

As per **claim 5**, Vance et al further discloses further includes a travel services notification module for forwarding said travel services message from said business partner to said employee with respect to said employee's identification code (col 4, lines 5-30, see Figure 1).

As per **claim 19**, Vance et al does not explicitly disclose further including a step (4) after said step (3), said step (4) includes: 4) said business partner forming a travel services message respective to said employee's identification code and then forwarding the travel services message to said travel system. However, Vance et al discloses that a travel service request is formed, sent to a supervisor for approval, and then forwarded to a travel system by a travel agent (col 7, lines 6-18). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to form and forward the travel request of the employee only after receiving approval of the travel policy from a supervisor because regardless of the order of the steps the supervisor still has the capability of confirming whether or not the employee's request is within the company policy.

As per **claim 20**, Vance et al further discloses further including a step (5) after said step (4), said step (5) includes: 5) said travel system further forwarding said travel

services message to said employee (col 12, lines 1-5). Vance et al does not explicitly disclose that the travel service message is in respect to an employee's identification code. However, it would have been obvious to one of ordinary skill in the art at the time of the invention to return the message with respect to said employee's identification code to uniquely identify each employee.

5. **Claims 6 and 21** are rejected under 35 U.S.C. 103(a) as being unpatentable over Vance et al [U.S. Patent No. 6,442,526] in view of Udelhoven et al [U.S. Publication No US 2002/0077871].

As per **claims 6 and 21**, Vance et al discloses all the limitations of claims 1 and 16. Vance et al does not disclose wherein said employee's basic data includes an identification code, a birthday and a passport number of said employee. However, Udelhoven et al discloses a reservation system in which a corporate traveler has a travel record that includes a date of birth and passport information (0047; 0061). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the invention of Vance et al to include the system discloses by Udelhoven et al for security purposes.

6. **Claims 8 and 23** are rejected under 35 U.S.C. 103(a) as being unpatentable over Vance et al [U.S. Patent No. 6,442,526] in view of Patullo et al [U.S. Publication No. US 2005/0033613].

As per **claims 8 and 23**, Vance et al discloses all the limitations of claims 1 and 16. Vance et al does not disclose wherein said business partner performs said travel services of insurance in accordance with said travel services data. However, Patullo et al discloses a travel agent that can obtain travel insurance for a client (0037). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the invention of Vance et al to include the system disclosed by Patullo et al for the customer convenience of not having to contact separate individuals for travel and insurance arrangements.

6. **Claims 12 and 27** are rejected under 35 U.S.C. 103(a) as being unpatentable over Vance et al [U.S. Patent No. 6,442,526] in view of Mori et al [U.S. Publication No. US 2002/0133428].

As per **claims 12 and 27**, Vance et al does not disclose wherein said business partner is an insurance agent. However, Mori et al discloses a system in which travel insurance is received through an insurance company (0049). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the invention of Vance et al to include the system disclosed by Mori et al because some travel agencies do not want to have the liability associated with obtaining travel insurance for their clients. In a case where a travel agent does not want the liability, a customer may request insurance information from an insurance agent directly.

Conclusion

Examiner's Note: Examiner has cited particular columns and line numbers in the references as applied to the claims below for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested that the applicant, in preparing the responses, fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shannon S. Saliard whose telephone number is 571-272-5587. The examiner can normally be reached on Monday - Friday, 8:00 am - 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John W. Hayes can be reached on 571-272-6708. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Shannon S Saliard
Examiner
Art Unit 3639

sss

JOHN W. HAYES
PRIMARY EXAMINER